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PATENT APPLICATION

ATTORNEY DOCKET NO. 10991381-1

"Expedited Procedure"
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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 11 2005

Inventor(s): Masumi Senoo et al.

Confirmation No.: 7749

Application No.: 09/506,407

Examiner: Ebrahimi D. Saeid

Filing Date: Feb. 17, 2000

Group Art Unit: 2626

Title: Configurable Printer Menu Structure

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on Aug. 11, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Number of pages: 10

Typed Name: Tanja F. Paulin

Respectfully submitted,

Masumi Senoo et al.

By 

Steven R. Ormiston

Attorney/Agent for Applicant(s)

Reg. No. 35,974

Date: Oct. 11, 2005

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APPELLANTS'/APPLICANTS' REPLY TO THE EXAMINER'S ANSWER

Applicants Elect To Maintain The Appeal.

In response to the Applicants' Opening Brief On Appeal, the Examiner issued a non-final Office Action purporting to reopen prosecution and advancing new grounds for rejection.

Rule 41.39(a) (37 U.S.C. § 41.39(a)) provides that the Examiner may furnish a written answer to the appeal brief and that the Examiner's answer may include new grounds of rejection. If the Examiner's answer contains a rejection designated as a new ground of rejection, then the Applicants may request that prosecution be reopened before the primary examiner by filing a reply under Rule 1.111 or that the appeal be maintained by filing a reply brief under Rule 41.41. 37 U.S.C. § 41.39(b).

Rule 41.39 does not seem to contemplate an Examiner's action reopening prosecution in response to the appeal brief. The Applicants have, therefore, construed the Examiner's action as an answer designating new grounds for rejection under Rule 41.39(a)(2). Accordingly, pursuant to Rule 41.39(b)(1), Applicants are requesting that the appeal be maintained by filing this reply brief under Rule 41.41.

Ta Does Not Teach All Claim Limitations

Claims 1-20 now stand rejected under Section 102 as being anticipated by Ta (5500715).

Claim 1 recites creating a printer menu structure and installing the printer menu structure on an erasable storage device in a printer. The Examiner cites to Ta Fig. 1

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Item 104, column 7, lines 45-52 and Fig. 2 block 202, column 8, lines 31-34 in support of the rejection of Claim 1.

Ta teaches assembling printing menu selections to form a final set of printing instructions for a print job. Abstract, lines 1-2. Ta is all about selecting menu options, not creating and installing menu structures. In Item 104 in Ta Fig. 1, the "user selects desired and/or relevant options from the [PC] setup menu, in preparing to obtain the desired print output." Ta column 7, lines 50-52. In item 202 in Ta Fig. 2, the user inserts a diskette containing the print job and PC setup menu selections into the printer diskette drive/reader. Item 202 is the first step in an overall method illustrated in Fig. 2 through which the user can change the PC setup menu selections that accompany the print job on the diskette using the printer setup menu. Ta, column 8, lines 28-54. There is no menu structure (or anything else) installed on the printer in the method illustrated in Ta Fig. 2. In fact, it is clear that the printer setup menu is already installed on the printer – the structure for the printer setup menu, therefore, has already been created and installed. Of course, there is no suggestion at all in Ta that the printer setup menu structure is installed on an erasable storage device in the printer. On the contrary, the clear implication is that the printer setup menu structure is a conventional printer menu structure permanently stored in a read only memory, as discussed in the Background section of the instant Application.

For all of these reasons, Claim 1 is felt to distinguish patentably over Ta. Claim 16 is a computer readable media counterpart to Claim 1 and distinguishes over Ta for the same reasons as Claim 1.

The same analysis applies to added limitations in dependent Claims 2-3 and 17, which recite installing the menu structure replaces (Claims 2 and 17) or extends (Claim 3) any menu structure previously installed on the printer. The Examiner asserts incorrectly that replacing menu selections and adding menu selections meets the added limitations in Claims 2 and 3. Replacing menu selections is not the same as replacing a menu structure. Adding menu selections is not the same as extending a menu structure. (It is interesting to note that the Examiner's premise is incorrect in any event – Ta teaches at column 8 that the printer setup menu selections over-ride any selections received on a diskette from the PC printer setup menu.)

Claim 11 recites a printer having a data communication interface coupled to the printer display panel to allow the printer to receive a printer menu structure from a

remote device. With regard to this element of Claim 11, the Examiner states that "note Fig. 4 item 14, column 4 lines 58-64 where the user interface 14 would allow user [sic] the selection of the specific menu options." Apparently, the Examiner is asserting that printers with an interface that allows the printer to receive menu selections from a remote device were known in the art. Even assuming this is true, it has no relevance to the limitations in Claim 11. A menu selection is not a menu structure. A conventional printer typically can receive printer menu selections from a driver installed on a computer remote from the printer. So far as Applicants are aware, however, such printers were not capable of also receiving a printer menu structure. Certainly, there is nothing in Ta that teaches or suggests a printer capable of receiving a printer menu structure from a remote device.

Respectfully submitted,



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Claim 11 recites a printer having a data communication interface coupled to the printer display panel to allow the printer to receive a printer menu structure from a

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remote device. With regard to this element of Claim 11, the Examiner states that "note Fig. 4 item 14, column 4 lines 58-64 where the user interface 14 would allow user [sic] the selection of the specific menu options." Apparently, the Examiner is asserting that printers with an interface that allows the printer to receive menu selections from a remote device were known in the art. Even assuming this is true, it has no relevance to the limitations in Claim 11. A menu selection is not a menu structure. A conventional printer typically can receive printer menu selections from a driver installed on a computer remote from the printer. So far as Applicants are aware, however, such printers were not capable of also receiving a printer menu structure. Certainly, there is nothing in Ta that teaches or suggests a printer capable of receiving a printer menu structure from a remote device.

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